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IN THE

Supreme Court of the United States

OCTOBER TERM 1967

No. 1384 AND No. 1408

MODERN PLASTIC MACHINERY CORP.,

Petitioner,

vs.

FRANK W. EGAN & COMPANY and
WILLIAM H. WILLERT,

Respondents.

PETITIONER'S REPLY BRIEF IN OPPOSITION TO RESPONDENTS' BRIEF

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Introduction

A reply brief is required in the present case because Respondents found fit to introduce new arguments first raised in the brief in opposition and to continue their misleading tactics by either submitting incomplete presentations contrary to the facts or by avoiding the issues on the merits altogether.

It is rather surprising to find that Respondents still make an attempt to allege validity of Claims 1 and 4 of the patent in suit, in spite of the fact that the newly presented Patent No. 1,533,191 to Kaiser *et al.* amounts to a complete anticipation of the alleged novel concept of Willert under 35 U.S.C. 102.

This reply brief is respectfully submitted under Rule 24(4) of the Supreme Court of the United States.

Respondents attempt to characterize the present case as an *ordinary* patent suit. Yet on page 22 of Respondents' brief they state as follows:

> "The fact is that the *majority* of the industry has paid tribute to the Willert Patent by accepting licenses at a reasonable royalty under the patent."

It appears, as presented in 611a, that 12 U. S. companies and 5 foreign companies, located in Sweden, Switzerland, Germany and Japan have been licensed under the patent in suit and many other companies in the U. S. and foreign countries have been threatened with litigation for alleged infringement of the Willert patent. The allegation that the present case is an ordinary patent suit is thus contradicted by Respondents' own statements.

Questions Presented

Respondents raised the procedural question, whether or not review by this Hon. Court of the judgment rendered by the Court of Appeals remanding this cause to the District Court to determine the issue of infringement or review of the order denying Petitioner's motion, is premature. There cannot be any doubt that the judgment on the issue of validity of the patent in suit is *final* and appeal lies to this final judgment only during a 90-day period. If no appeal would be taken during this term, Petitioner would be deprived of the right to appeal. Finally, in case of a reversal of the judgment of the Court of Appeals, the issue of infringement would be moot, and the entire case would be terminated.

Respondents refer in addition to a separate question raised by the second-filed petition, whether or not this Court should consider, or should order either court below

to consider, evidence not made a part of the record in the trial court. The apparent reason is the public interest involved with patents and also that both the *validity and infringement issues* are integrally related in patent controversies. In

> *Gairing Tool Co.* v. *Eclipse Interchangeable Counterbore Co.*, 48 F. 2d 73 (6th Cir. 1930), reh. denied;

The Court said:

> "If such evidence be sufficient, to avoid a decree of injunction and accounting against other manufacturers or users, the Appellant should not be the only manufacturer so enjoined.
>
> . . .
>
> It is accordingly ordered herein that the mandate be stayed, the decree of affirmance heretofore entered herein be suspended, that leave be granted to file a petition in the District Court to reopen this cause, and that the cause be remanded to the District Court for the purpose of entertaining such petition; but should such petition to reopen be granted, it is further ordered that Appellant pay to Appellee the sum of $2,500.00 expenses and counsel fees, as a condition for securing such relief."

The law in such situation has been clearly stated in the legal memorandum attached to Petitioner's motion in the Court of Appeals.

On page 9 of said motion Petitioner offered the assumption of costs and attorney fees for the requested additional proceeding, *in spite of the fact* that the late presentation of the new evidence was caused solely by the fact, that Respondents *in a shift of their position* produced a new concept never raised before and particularly not before the District Court, as will be set forth below.

Statutes and Rules

Rule 52(a), F.R.C.P., is definitely involved because the Court of Appeals ignored the finding of fact by the District Court without declaring such findings of fact as "clearly erroneous" and was bound to accept such findings. As a matter of fact, the Court of Appeals based its decision on facts which are in clear contradiction with the findings of fact by the District Court.

35 U.S.C. 101 and 102 are also pertinent on the substantive question. The District Court in its opinion disposed of § 102 by stating that "there is also a question of novelty of the patent in suit, but what will be said as to obviousness will be dispositive of this case."

Statement of the Case

1. The Proceedings Below

Respondents stated on page 5 of their brief that the U. S. Court of Appeals for the Third Circuit concluded, in a careful opinion, that the District Court had not correctly applied the legal test of obviousness in light of this court's recent instructions in *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966), and *United States* v. *Adams*, 383 U. S. 39 (1966). It will be shown below that the Court of Appeals erred in the application of *United States* v. *Adams* (*supra*).

Respondents also make reference in a footnote in their brief to the action in the United States District Court for the District of Connecticut, referred to at pages 2 and 6 of the petition in No. 1384 indicating that said action was settled by Defendant taking a license under the Willert patent. Yet, Defendant in said action consulted counsel for Petitioner herein jointly with its general counsel and patent counsel and in spite of its stated conviction of invalidity of the Willert patent by said Defendant and its counsels, a license under the Willert patent has been taken

solely because said Defendant considers the litigation expenses as prohibitive. It should be stated in this connection that several other licensees under the Willert patent approached counsel for Petitioner herein through their counsel and likewise indicated their conviction of invalidity of the Willert patent, yet did choose a license in order to save litigation expenses.

2. The Background of the Invention in Suit

Respondents stated on page 5 of their brief that "the Willert patent relates to a plastics injection molding machine for plasticizing and delivering to a mold plastics material at high speed and under high pressure, and under critically controlled conditions." Respondents further stated on page 6 that since the 1930's many skilled workers in the plastics injection molding machine field had devoted much time and energy in a futile search for an adequate plasticizing and injection unit. Finally Respondents state that by interrelating old elements in his new combination, Willert succeeded in solving the industry's long standing problem.

The patent specification of Willert states in column 1, lines 18 to 21 (584a) "in its broadest aspects, such mechanism can be employed without a mold, for example as a supply for plastic material in plastic blow molding operations" and in column 1, lines 23 to 25, "the mechanism of the invention delivering plasticized material under high pressure into the mold . . ." The same means, functioning in exactly the same manner, have been shown as known in the prior art considered by the District Court and in particular also in Kaiser *et al.*

Apparently in their desperation Respondents continue the allegation of a notion that Willert is the inventor of features clearly found in the prior art as will be set forth below, though it should be clear to Respondents, that the plasticizing and injection unit alleged to be Willert's in-

vention is found in the prior art, pertinent to the patent in suit.

Respondents make reference on page 12 of their brief to a limit switch to be adjustable longitudinal of the bed 22, in such position as to be closed by the carriage 50 when the latter has traveled a predetermined distance to the right.

In the District Court opinion (A 43) Judge Wortendyke stated: "In the Goessling application of Dec. 21, 1942, column 2, line 55 of the specification it is said: '*In accordance with common practice,* automatic controls (not shown) are provided so that the mold and ram are operated in proper timed relation and in repeated cycles.'" The District Court opinion quotes on page 40, App. A, a rejection letter of the Patent Office where the Examiner states in connection with the limit switch as follows: ". . . This is particularly true since Dinzl discloses the actuation of a switch to actuate a control circuit which actuation is caused by a rearward movement of the injection ram. Therefore no invention is seen in controlling the operation of the apparatus of the Italian patent automatically, the control means being responsive to the rearward movement of the screw."

3. The Prior Art

Respondents stated on page 13 of their brief that "the conceded fact that each structural element of Willert's patented combination was old does not diminish that magnitude of his contribution" and Respondents state further that "the Court of Appeals' opinion, specifically recognizing that the Willert combination was made up of old elements unhesitatingly and properly held the patent valid". In this connection Respondents make reference to *United States* v. *Adams,* 383 U. S. 39 (1966).

It is amazing that Respondents still dare to compare the situation found in the patent in suit with the situation

applied by this Hon. Court to *United States* v. *Adams* (*supra*).

The patent adjudicated in the *Adams* case relates to a non-rechargeable, as opposed to a storage, electrical battery, and the battery comprises two electrodes one made of magnesium, the other of cuprous chloride, which are placed in a container. If the use of magnesium for zinc and cuprous chloride for silver chloride were merely equivalent substitutions, it would follow that the resulting device, namely *Adams'*, would have equivalent operating characteristics, but it does not. The Court below found, and the Government apparently admits, that the *Adams'* battery *"wholly unexpectedly"* has shown "certain valuable operating advantages over other batteries." The operating characteristics of the *Adams'* battery have been shown to have been *unexpected* and to have far surpassed then-existing wet batteries. Since the *Adams'* battery brought about an unexpected result and novel function, the *Adams'* battery was found as nonobvious.

The adjustable back pressure as found in the prior art uses the same structural elements and functions in the same manner as in the Willert structure, and even Respondents do not claim that the Willert patent brings about an unexpected result. Thus *no unexpected result* is found in the Willert patent and for this reason the present case falls completely into the doctrine of *Graham* v. *John Deere Co.* (*supra*), and *not* into the doctrine of *United States* v. *Adams* (*supra*).

While the term "adjustable back pressure" was used in the above discussion, emphasis must be made to the fact that neither the specification of Willert, nor the claims of the Willert patent make reference to such term and no definition can be found therefor as an antecedent in Willert's specification. It is evident the Respondents present reliance upon this feature was the afterthought of an astute patent trial lawyer.

Yet Rule 75* of the Rules of Practice of the United States Patent Office expressly requires that the specification provides an antecedent for such term.

1. The Italian patent (658a) makes mention of back pressure without mentioning adjustability thereof, yet claims 1 and 4 of the patent in suit *lack likewise the call* for adjustability of back pressure.

2. Respondents state on page 14 of their brief, again in a surprisingly daring manner that "Wiedmann's device serves a function foreign to that employed by Willert in his plastics injection molding machine". Wiedmann (683a) states in his specification on page 1, left column, lines 1 to 4 (685a) that:

> "this invention relates *primarily to hydraulic transmissions,* the motors of which should have a back pressure maintained thereon during a part of a cycle of operations . . ." (emphasis added)

and on page 1, column 1, lines 11 to 15:

> "for the *purpose of illustration,* the invention will be explained as applied to a broaching machine having a

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*Rule 75. Claim. (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

(c) When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim.

(d) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

vertically reciprocable tool slide but it is to be understood that the invention is not limited to such use."

It is thus evident that Wiedmann had no intention to limit his invention to a broaching machine and applied his invention merely by example and in compliance with the Rules of Practice of the United States Patent Office to a broaching machine. The Wiedmann patent relating to a hydraulic transmission clearly discloses hydraulic controls in which adjustable back pressure is applied, and is available to a man skilled in the art looking for hydraulic controls.

Respondents even lose themselves in denying Petitioner's assertion that Wiedmann's arrangement maintains a "constant back-pressure". While Respondents claim that such statement by Petitioner is wrong, attention is called to the specification of Wiedmann and in particular to page 2, right column lines 6 to 9 (686a) where it is stated:

> "downward movement of piston 3 is at first resisted by the combined resistances of resistance valves 10 and 21 which maintain a *predetermined back-pressure* on piston 3."

It is not surprising to find that Respondents accuse Petitioner to be wrong, when actually Respondents are wrong. Where else would the man skilled in the art look for a hydraulic control in combination with adjustable back-pressure than in the art for hydraulic transmissions. The holding of the Court of Appeals that Wiedmann's hydraulic system is "in a different context" and pertains to "remote cited art" is not understood and is obviously made in error, particularly since the application of the hydraulic control to a broaching tool is given by example only and the broaching tool is even not shown in the drawings (see Wiedmann's specification, page 2 left column lines 66 and 67, 686a).

3. Concerning the Willcox patent, Respondents confine themselves to the statement that "Petitioner's patent expert agreed also that as Willcox's screw is pulled rearwardly, there is no adjustable back-pressure (309a, 550a)". It is just amazing that Respondents dare to present to this Hon. Court the quoted statement without adding the clear withdrawal by the same expert of said statement and attention is called to the following additional testimony (366a) of the same patent expert:

> "A. I made that statement but it was an error. That conclusion is wrong. There is back pressure in the Willcox patent, as I repeatedly said, when the liquid is expelled from a cylinder by movement of the piston and looking at Willcox by movement of the piston 28 to the right, the liquid behind the piston exits through the conduit 32 and the resistance set up by the pressure of the fluid is a back pressure. There is a back pressure (770) in Willcox.
>
> Q. Is that the reason why there must be a back pressure? Would you elaborate on this point? Please explain very clearly to the Court why there must be a back pressure. A. There must be a back pressure because when the fluid comes in through port 32 to move the piston all the way to the left, the cylinder is filled with fluid and when fluid is admitted through port 32 to move the piston to the right, that fluid behind the piston 28 is restricted in its flow through the passage 32 and a reaction, a force or pressure is set up in that liquid as it is forced through the orifice 32 which is small in comparison to the diameter of the piston, such that there is a resisting force in the fluid to the advance of the piston 28 rearwardly."

The reference to an exhaust conduit system under the control of a valve arrangement (not shown) completes the anticipation of "adjustable back pressure" by using *a control valve* (682a), as disclosed in Willcox.

It has been stated above that Respondents throughout the proceedings maintained that adjustable back pressure is a novel feature conceived by Willert, yet Respondents shifted their position for the first time in Appellants' reply brief before the Court of Appeals and on page 10 of that reply brief Respondents pointed to the fact that Judge Wortendyke's holding of obviousness turns on his view that because the means described by Willert to adjust and control back pressure—a pressure relief valve in the hydraulic system—was structurally old, as shown by Wiedmann, and "functioned" in Wiedmann, its use with the other conventional elements of a reciprocating screw injection molding machine could not amount to invention, because that "function" was known to the art.

Respondents presented for the first time in said reply brief that the legal test of obviousness in this case is *not* whether means for adjusting back pressure could readily be selected once someone had the concept of making such adjustments to control plasticizing in an injection molding machine. Rather the test is whether this concept itself was obvious, referring erroneously to *United States* v. *Adams* (*supra*).

Obviously, Respondents realized that they could not deny any more that Wiedmann stands for adjustable back pressure and shifted to the theory that the invention of Willert resides in the application of such adjustable back pressure, as known *per se* by Wiedmann, to control plasticizing of plastic material. If Respondents would have taken such position before the District Court, the Kaiser *et al.* patent would have been produced before which clearly stands for the fact that the use of adjustable back pressure to control plasticizing of plastic material was available in the 1930's. As a matter of fact, the concept of using adjustable back pressure to control plasticizing of plastic material is clearly anticipated under 35 U.S.C. 102 by Kaiser *et al.*, and no more only by 35 U.S.C. 103 on the ground of obviousness.

It is rather significant that the fact that the 1925 patent to Kaiser *et al.* (1408 App. B), the subject of No. 1408, which amounts to a complete anticipation of the concept of plasticizing plastic material in a plastic feeding machine, is completely ignored under 35 U.S.C. 102 by Respondents and merely put aside by a statement, that shows no more than the art considered by the Patent Office and by the Courts below is dissimilar from the patent in suit, which statement is made on page 15 of Respondents' brief and on page 16 it is merely added that Kaiser was readily available to petitioner below, it adds nothing to the prior art considered by each tribunal below and it differs distinctly from the invention. It is utterly absurd not to recognize that the last retreating point by Respondents is clearly taken away by the Kaiser *et al.* patent and it is undoubtedly for this reason why Respondents do not dare to enter a discussion on the merits of the Kaiser *et al.* patent or even to hint where any distinction could be found between the structure of Willert, on the one hand, and the Kaiser *et al.* structure, on the other hand, particularly concerning the concept of employing adjustable back pressure for the purpose of plasticizing the plastic material in a plastic feeding machine.

In their usual misleading and confusing manner, Respondents even do not hesitate to state that the patent to Kaiser *et al.* (App. B) the subject of No. 1408 is not duly discovered, *shows no more than the art considered by the Patent Office* and by the Courts below and is dissimilar from the patent in suit. There is no basis in fact that the Patent Office considered the Kaiser *et al.* patent.

The fact is rather that the following references were cited in the file of the Willert patent taken at the bottom of col. 10 of the Willert patent (588a).

References cited in the file of this patent

UNITED STATES PATENTS

2,359,839	Goessling	Oct. 10, 1944
2,402,805	Cousino	June 25, 1946
2,471,813	Cousino	May 31, 1949
2,493,805	Dinzl	Jan. 10, 1950
2,629,132	Willcox	Feb. 24, 1953

FOREIGN PATENTS

420,839	Italy	Mar. 9, 1947

Since this patent has not been cited by the Patent Office and has not been considered by the Patent Office or the Courts, the presumption of validity of the Willert patent is of course extremely weakened. Notwithstanding Respondents' attempt to minimize Kaiser *et al.*, this reference teaches the very same concept on which Respondents wish to base their invention.

Reasons for Denying the Writs

Surprisingly, the Court of Appeals, as stated on page 17 of Respondents' brief, gave "measured weight" to the so-called secondary considerations and concluded that the Willert invention "represents a significant advance in the field" (1384, App. B, p. 62). Without any reasoning the Court of Appeals again ignores the findings of facts, so well stated in the correct and able opinion of the District Court, namely that Judge Wortendyke disclosed his findings of facts as follows:

> "We need not consider the effect of such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc. in this case. As was brought out upon the direct examination of Willert by Defense Counsel, *it is obvious that the so called*

Egan machine with the trademark Reciproscrew is not the embodiment of the Willert patent under which it has an exclusive license."

What was said by the Court in *Photon Inc.* v. *Harris-Intertype Corp.*, 235 F. Sup. 921, 927 (D. Mass. 1964, Aff'd *per curiam* 349 F. 2d 856 (1st Cir., 1965), cert. denied, 382 U. S. 1011 (1966) *sub nom. Tansel* v. *Photon Inc.*, is equally applicable and I quote: "It is significant to note that Plaintiff . . . did not come into Court and offer evidence of having previously marketed a machine based on the . . . [Willert patent] which has enjoyed any commercial success whatsoever and which . . . [Plaintiff] claims Defendant has pirated." (Insertions by Judge Wortendyke.) How under the circumstances the Court of Appeals could consider secondary considerations, if no commercial success has been found in the findings of fact, is entirely unclear and Respondents rely on such erroneous considerations.

Respondents accuse Petitioner that Petitioner seeks to undercut the soundness of these holdings by contending that Respondents misled the Court of Appeals in asserting there a "new theory" that the "alleged novel concept" was "adjustable back pressure" said by Petitioner to be "an afterthought" and "a fiction". If Respondents would have been in the position to show that the specification or the claims make reference to the term "adjustable back pressure", they would have rendered a service to their cause, however, since their specification and claims of the Willert patent are silent about this term and do not provide any antecedent or definition for this term what it means in connection with the Willert structure, Respondents must accept Petitioner's allegation that the alleged concept of "adjustable back pressure" amounts really to an "afterthought", a "fiction" or "gimmick", in order to create a semblance of alleged invention.

Apparently Respondents refuse to recognize a defeat when they are driven out from their last position of re-

treat with the new theory acquired in the Court of Appeals that the invention resides now in the application of adjustable back pressure known *per se* by Wiedmann in connection with the plasticizing of plastic material.

Counsel for Respondents Suffered Defeat

Another case decided very recently by the Court of Appeals in the Second Circuit in which case Counsel for Respondents herein presented likewise the Patentee and in pursuing the same tactics as applied in the present case found that in a situation where the claims define a combination of old elements a combination invention is not patentable unless the whole is more than the sum of the parts.

This case is *Continental Can Company Inc.* v. *Old Dominion Box Company et al.*, 157 U.S.P.Q. 353. Since this case has not been reported yet in the Federal Second, Petitioner submits attached herewith a photostatic copy of that case published under 157 U.S.P.Q. 353 under Appendix G. As in the present case, Counsel for Respondents herein also admitted in that case that all elements of the claims are old and known and said invention resides in the combination of said old elements. Both, the District Court and the Court of Appeals in the Second Circuit, recognized, however, that a greater demand must be made if the invention resides merely in the combination of old elements. The Court of Appeals for the Second Circuit recognized that

> "the danger of removing existant knowledge from the public domain is more acute with respect to inventions involving a combination of elements or devices common in the prior art and, therefore, 'courts should scrutinize combination patent claims with a care proportionate to the difficulty and improbability of finding invention in assembly of old elements.' Great Atlantic

and P Tea Company v. Supermarket Eq. Corp., 340 U. S. 147, 152 (1950)."

The Court of Appeals also found that commercial success and solution of a long standing need in the art are secondary considerations which cannot breathe life into a patent otherwise invalid because of obviousness.

Respondents finally allege that the judgment and the order of which review is here sought are not final. On the other hand, Respondents do not indicate at all what recourse would be available for Petitioner save the present petition for certiorari. *Hamilton-Brown Shoe Company* v. *Wolf Brothers & Company,* 240 U. S. 251, 258 (1916), does not apply to the present case because as clearly stated in this case a petition for certiorari was filed against a judgment which was not final. It is for this reason that this case would not apply to the present case.

Conclusion

It is Respondents' contention that these petitions represent nothing more than attempts by a defeated litigant to obtain further review on the methods of a judgment of patent validity. Actually these petitions represent sincere attempts to correct a great error committed by the Court of Appeals for the Third Circuit. It appears that Respondents attempt to hide behind general phrases or by not facing the issues, since Respondents failed to respond to the Kaiser *et al.* patent on its merits. The Respondents' reference to *Magnum Import Co.* v. *Coty,* 262 U. S. 159, 163 (1923), is again significant. In significant manner Respondents did choose to cite from that case out of context and the sentence preceding the sentence stated by Respondents reads as follows:

"The jurisdiction to bring up cases by certiorari from the Circuit Court of Appeals was given for two pur-

poses: first, to secure uniformity of decision between those courts in the nine circuits; and second to bring up cases involving questions of importance which is in the public interest to have decided by this court of last resort."

There cannot be any doubt that in view of the 17 licenses issued under the patent's innumerous threats to a great part of the industry in the United States and in foreign countries and last but not least the Respondents' admission that a majority of the specific industry is concerned with the Willert patent, the present case involves questions of importance which, in the public interest should be decided by this Court of last resort.

The first petition No. 1384 is warranted in order to correct a great error rendered by the Court of Appeals for the Third Circuit which is of greatest interest to the majority of the plastic industry in the United States and in foreign countries and the necessity for said petition cannot be demonstrated better than pointing to lack of convincing statements bringing out patentable distinctions between the Willert patent and the prior art patents considered by the courts below. Finally also a striking distinction of the case of *United States* v. *Adams* was clearly set forth above which indicates beyond any doubt that *United States* v. *Adams* was decided in favor of the inventor because by his teaching he brought about an unexpected result, while in the present case even Willert does not dare to mention that his invention brings about an unexpected result.

The second petition No. 1408 aiming at a reversal of the decision upon the motion to reopen the case before the District Court in view of the newly presented Kaiser *et al.* patent should be granted since Respondents' apparent refusal to deal with the merits of this patent, is tantamount to an admission of the anticipation of the alleged Willert

invention. For this reason the writ should also be granted to the second petition.

It should finally be emphasized that in case the writ for the first petition is granted and the decision of the Court of Appeals is reversed, the second petition becomes moot.

Respectfully submitted,

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Appendix G

(See opposite ☞)

Court of Appeals, Third Circuit

THE GENERAL TIRE & RUBBER COMPANY v. ISOCYANATE PRODUCTS, INC.

Nos. 16737-8 Decided Apr. 16, 1968

Appeals from District Court for District of Delaware, Wright, Ch. J.; 155 USPQ 339.

Action by The General Tire & Rubber Company against Isocyanate Products, Inc., for patent infringement.

Action by Isocyanate Products, Inc., against The General Tire & Rubber Company for declaratory judgment of patent invalidity.

From judgment denying motion by The General Tire & Rubber Company to dismiss declaratory judgment action and granting motions by Isocyanate Products, Inc., to add party and to enjoin prosecution of action in another court, both parties appeal. Affirmed.

JOHN T. KELTON and WATSON, LEAVENWORTH, KELTON & TAGGART, both of New York, N.Y., for The General Tire & Rubber Company.

C. WALTER MORTENSON and MORTENSON & WEIGEL, both of Wilmington, Del., for Isocyanate Products, Inc.

Before MCLAUGHLIN, FORMAN, and FREEDMAN, Circuit Judges.

PER CURIAM.

On a full consideration of the arguments of appellant we are satisfied that the district court acted within the allowable range of its discretion. The reasoning expressed in its opinion, reported at 270 F.Supp. 868, 155 USPQ 339 (D.Del. 1967), fully justifies the conclusion that its discretion was wisely exercised.

The judgment will be affirmed.

Court of Appeals, Second Circuit

CONTINENTAL CAN COMPANY, INC. v. OLD DOMINION BOX COMPANY, INC., et al.

No. 252 Decided Apr. 8, 1968

PATENTS

1. Courts of Appeals — Issues determined (§ 29.10)

In absence of cross appeal, court denies attorney's fees to appellee which obtained declaratory judgment that appellant's patent is invalid.—Continental Can Co., Inc. v. Old Dominion Box Co., Inc. (CA 2) 157 USPQ 353.

2. Patentability—Invention—In general (§ 51.501)

Issue as to what prior art is relevant depends upon what a skilled person in the field would be expected to know in connection with his art.—Continental Can Co., Inc. v. Old Dominion Box Co., Inc. (CA 2) 157 USPQ 353.

3. Patentability — Aggregation or combination—In general (§ 51.151)

Patentability—Invention — In general (§ 51.501)

It is not sufficient to support patentability that combination of elements be merely new or even represent a modest improvement in the art; such combination must also be nonobvious to person having ordinary skill in the art; danger of removing existent knowledge from public domain is more acute with respect to inventions involving a combination of elements common in prior art; combination invention is not patentable unless the whole is more than sum of the parts.—Continental Can Co., Inc. v. Old Dominion Box Co., Inc. (CA 2) 157 USPQ 353.

4. Patentability—Invention—In general (§ 51.501)

Failure to show that patents and prior uses anticipate patented invention under 35 U.S.C. 102 does not eliminate them from field of prior art under section 103.—Continental Can Co., Inc. v. Old Dominion Box Co., Inc. (CA 2) 157 USPQ 353.

5. Presumption from patent grant—Patent Office consideration of prior art (§ 55.5)

Presumption of patent validity is weakened by failure of Patent Office to consider important prior art.—Continental Can Co., Inc. v. Old Dominion Box Co., Inc. (CA 2) 157 USPQ 353.

6. Patentability — Evidence of—Commercial success—In general (§ 51.4551)

Patentability — Evidence of—Delay and failure of others to produce invention (§ 51.456)

Commercial success and solution of long-standing need in art are secondary considerations which cannot breathe life into patent invalid for obviousness.—Continental Can Co., Inc. v. Old Dominion Box Co., Inc. (CA 2) 157 USPQ 353.

7. Patentability — Evidence of—Solution by several parties (§ 51.465)

Simultaneous invention by third party buttresses conclusion that patented invention was obvious.—Continental Can Co., Inc. v. Old Dominion Box Co., Inc. (CA 2) 157 USPQ 353.

Particular patents—Paperboard Carrier

2,990,997, Weiss, Paperboard Carrier, invalid.—Continental Can Co., Inc. v. Old Dominion Box Co., Inc. (CA 2) 157 USPQ 353.

Appeal from District Court for Southern District of New York, Graven, J.; 155 USPQ 70.

Action by Old Dominion Box Company, Inc., and Dacam Corporation against Continental Can Company, Inc., for declaratory judgment of patent invalidity and nonfringement. From judgment for plaintiffs, defendant appeals. Affirmed.

WILLIAM K. KERR (DAVID W. PLANT of counsel) both of New York, N.Y., for appellant.

HAROLD JAMES (JAMES & FRANKLIN on the brief) both of New York, N.Y., for appellees.

Before WATERMAN and FEINBERG, Circuit Judges, and BARTELS, District Judge.*

BARTELS, District Judge.

Continental Can Company, Inc. appeals from a declaratory judgment of the District Court holding invalid for want of invention under 35 U.S.C.A. § 103, the patent known as A. J. Weiss Patent (2,990,997), relating to a rotary latching or locking action on wrap-around cartons or carriers, and also holding unenforceable under 35 U.S.C.A. § 135(c) any rights Continental might have had under the Weiss patent.

[1] Old Dominion Box Company, Inc. was engaged in the business of manufacturing and selling cartons and Dacam Corporation was engaged in the business of designing and licensing packaging machinery and equipment (both will be referred to as Old Dominion). In instituting the action Old Dominion alleged not only that the Weiss patent was invalid and unenforceable but also that the patent known as H. Ganz Patent (2,986,857), relating to a machine for wrap-around packaging including the Weiss carton, was also invalid and unenforceable. Infringement of both patents has been conceded and neither party appeals from that portion of the judgment holding the Ganz patent invalid. The trial judge did not rule upon certain claims of invalidity and unenforceability and decided others adversely to Old Dominion. Old Dominion filed no cross-appeal but asserts that all additional grounds supporting the District Court's ruling upon invalidity and unenforceability may nevertheless be considered upon this appeal, although decided adversely or not considered by the District Court. It also asserts the right to attorney's fees, which in the absence of a cross-appeal we hereby deny. Standard Acc. Ins. Co. v. Roberts, 132 F.2d 794 (8 Cir. 1942); North Texas Producers Ass'n v. Metzger Dairies, Inc., 348 F.2d 189, 197 (5 Cir. 1965), cert. denied, 382 U.S. 977 (1966).

The basic issue in this case is the validity of the Weiss patent. We affirm the District Court's finding of invalidity, rendering unnecessary the disposition of Old Dominion's additional claims and also the resolution of the issue of unenforceability.

Background

There are two general types of folding cartons, to wit: "set-up" cartons and "wrap-around" cartons. In the set-up carton the sidewalls are held in erected position by over-lapping and locking along the sides, leaving the top open in order to permit the contents to be inserted, thus requiring a two-step operation. In the wrap-around type of folding carton the contents are placed on the flat carton blank, which is thereafter erected by being wrapped around the contents and secured in place by locking together over-lapping closure panels, thereby completing the enclosure of the contents in a one-step operation.

There are also two types of "wrap-around" cartons, i.e., "open-ended" or four-sided and "closed-ended" or six-sided, the only difference being the presence or absence of the end walls. In wrap-around packaging, at least of the open-ended type, a carton design which insures a secure, tight package is vital. In such cartons the group of containers about which the carton blank is to be wrapped is positioned by the machine on top of the central panel, or that central panel may be placed on top of the containers. As the carton and the containers advance through the wrapping machine, the latter automatically folds the two side panels of the carton against the sides of the containers, and then folds the two closure panels into overlapping position. The carton is thus wrapped in open-ended, rectangular form about its contents, and finally the overlapping closure panels are fastened together by glue, staples, interlocking parts formed in the overlapping panels, or a combination of two of these alternatives. Glue closures, metal staples and punch locking systems or devices in wrap-arounds were found unsatisfactory for various reasons. There was a need for a machine and a carton which per-

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*Of the Eastern District of New York sitting by designation.

Particular patents—Paperboard Carrier

2,909,097, Weiss, Paperboard Carrier, invalid—Continental Can Co., Inc. v. Old Dominion Box Co., Inc. (CA 2) 157 USPQ 353

Appeal from District Court for Southern District of New York, Craven, J.

Action by Old Dominion Box Corporation against Continental Can Company, Inc., for declaratory judgment of patent invalidity and noninfringement. From judgment for plaintiffs, defendant appeals. Affirmed.

WILLIAM K. KERR (DAVIS, HOXIE, FAITHFULL & HAPGOOD, of counsel) both of New York, N.Y., for appellant.

HAROLD DAVIS (DAVIS & FRAZIKIAN on the brief) both of New York, N.Y., for appellees.

Before WATERMAN and FRIENDLY, Circuit Judges, and DAWKINS,* District Judge.

DAWKINS, District Judge.

Continental Can Company, Inc., appeals from a declaratory judgment of the District Court holding invalid for want of invention under 35 U.S.C.A. § 103 the patent known as A. J. Weiss Patent 2,909,097, relating to a rotary machine for locking action to wrap-around cartons or carriers, and also holding unenforceable under 35 U.S.C.A. § 154(c) any rights Continental might have had under the Weiss patent.

[1] Old Dominion Box Company, Inc., was engaged in the business of manufacturing and selling cartons and Diecraft Corporation was engaged in the business of designing and licensing packaging machinery and equipment (both will be referred to as Old Dominion). In instituting the action Old Dominion alleged, not only that the Weiss patent was invalid and unenforceable but also that the patent known as H. Glass Patent (2,960,857) relating to a machine for wrap-around packaging including the Weiss device, was also invalid and unenforceable. Infringement of both patents has been conceded and neither party appeals from that portion of the judgment holding the Glass patent invalid. The trial judge did not rule upon certain claims of invalidity and unenforceability and dismissed others adversely to Old Dominion. Old Dominion filed no cross-appeal but asserts, that all additional grounds supporting the District Court's ruling upon invalidity and unenforceability may nevertheless be considered upon this appeal, although decided adversely or not considered by the District Court. It also asserts the right to attorney's fees, which in the absence of a cross-appeal we deny by Standard Acc. Ins. Co. v. Roberts, 182 F.2d 791 (8 Cir. 1942); North Texas Producers Ass'n v. Metzger Dairies, Inc., 348 F.2d 189, 197 (5 Cir. 1965), cert. denied, 382 U.S. 977 (1966).

The basic issue in this case is the validity of the Weiss patent. We affirm the District Court's finding of invalidity, rendering unnecessary the disposition of Old Dominion's additional claims and also the resolution of the issue of unenforceability.

Background

There are two general types of folding cartons, to wit: "setup" cartons and "wrap-around" cartons. In the setup carton the sidewalls are held in erected position by over-lapping and locking along the sides, leaving the top open in order to permit the contents to be inserted, thus requiring a two-step operation. In the wrap-around type of folding carton the contents are placed on the flat carton blank, which is thereafter erected by being wrapped around the contents and secured in place by locking together over-lapping closure panels, thereby completing the enclosure of the contents in a one-step operation.

There are also two types of "wrap-around" cartons, i.e., "open-ended" or four-sided and "closed-ended" or six-sided, the only difference being the presence or absence of the end walls. In wrap-around packaging, at least of the open-ended type, a carton design which insures a secure, tight package is vital. In such cartons the group of containers about which the carton blank is to be wrapped is positioned by the machine on top of the central panel, or that central panel may be placed on top of the containers. As the carton and the containers advance through the wrapping machine, the latter automatically folds the two side panels of the carton against the sides of the containers, and then folds the two closure panels into overlapping position. The carton is thus wrapped in open-ended, rectangular form about its contents, and finally the overlapping closure panels are fastened together by glue, staples, interlocking parts formed in the overlapping panels, or a combination of two of these alternatives. Glue closures, metal staples and punch locking systems or devices in wrap-arounds were found unsatisfactory for various reasons. There was a need for a machine and a carton which per-

* Of the Eastern District of New York sitting by designation

mitted a rapid packaging operation producing a carton holding containers securely in the carton and one which could be easily opened and closed. A properly designed machine was just as essential as a properly designed carton, as evident from the use of the Ganz machine for the purpose of packaging the Weiss carton. The trial judge found that "[i]n the matter of invention claimed by the defendant, those patents are closely intertwined." Similarly, the machine which was the subject matter of Arneson Patent No. 2,931,152, cited against the Ganz machine, was designed for use in packaging a carton (asserted by Old Dominion as anticipating the Weiss carton), depicted but not patented.

Weiss Invention

This invention relates to paperboard cartons and more specifically, to those which are wrapped around a group of containers. Weiss first conceived his invention on October 8, 1957, for which he filed an application on July 15, 1958, and thereafter received a patent on July 4, 1961. The patent describes a wrap-around carrier, typical examples being the familiar "six-pack" carriers of beer or soft drink cans or bottles.

The substance of the invention appears in Claim 1, where Weiss describes the design of a wrap-around carton with two side panels to be folded against the sides of the cans, and two closure panels to be folded into an overlapping position and then fastened by a rotary action of hooking a latching flap with the catches and tongues in one overlapping closure panel into the latch openings and slots in the other overlapping closure panel, thus producing automatic tightening. In his specifications Weiss stated that it was not too difficult to obtain fastening which produced tightness, but that it was rather difficult to combine the attribute of tightness with the unique facility of easily opening the wrap-around structure.[1] In describing the action of the latch, Weiss said that "the rotary latching action can, *if desired*, produce an automatic tightening of the package as it cams or levers the closure panels into fully closed overlapping position"[2] (emphasis added). The trial judge found that beyond the normal tightness of the container due to its dimensions and extent of overlap, the rotary action produces an automatic tightening effect of about 1/32 of an inch. Accordingly, the locking structure of the Weiss patent may or may not produce automatic tightening, depending upon the spatial relationship of the overlapping closure panels at the time the carton lock structure is pivoted. Only in Claim 1 does Weiss mention that "the action of the catch will produce an automatic tightening of the side walls against the contents as it cams or levers the closure panels into the fully closed overlapping position."[3]

Prior Art

A number of prior art patents were introduced into evidence, of which only seventeen were pertinent; eleven related to six-sided, folding cartons, and six related to open-end wrap-around cartons. The six wrap-around carton patents relied upon are: Gentry 2,786,572, Gentry, 2,827,165, Andre 2,911,096, and Stone 2,975,891, all pertaining to cartons held together by punch locks; Grinspoon 2,798,603, pertaining to cartons held together by tuck flaps; and Currivan 2,922,561, pertaining to cartons held together by glue. These carton patents do not embody the same type of locking arrangement, nor suggest the combination of tongue, catches and openings employed by Weiss, although the design of the cartons is essentially the same.

The most important of the six-sided, folding carton patents relied upon by Old Dominion are Trogman 2,102,497, Morrison 1,104,821, Close 1,669,454, Pergande 2,060,240, Poe 2,316,362, Crary 2,419,391, Kells 2,572,159, Lighter 2,395,558, and the French Patent 1,063,058.[4] There are also two instances of prior public use of the Ray Paper Box and the Robertson Paper Box, both six-sided wrap-around cartons completely enclosing their contents, which were made and sold in 1951 and 1954. They teach the use of overlapping panels, matching tongues with catches and openings in a locking arrangement for six-sided cartons essentially the same as the arrangement used by Weiss. With the possible exception of the Morrison and French patents, none explicitly recognized the automatic tightening effect resulting from the Weiss combination.

Locking arrangements, typical of the teachings found in the prior art folding cartons, appear in the Morrison and the French patents. Morrison, in his specifications, describes a form of corner locking of adjoining sidewalls of a set-up box by the insertion of tongues and catches on flaps on one sidewall into a set of slots on the adjoining sidewall, to enable the adjoining end to be quickly locked in a durable position. He states that the "straightening of the flap after

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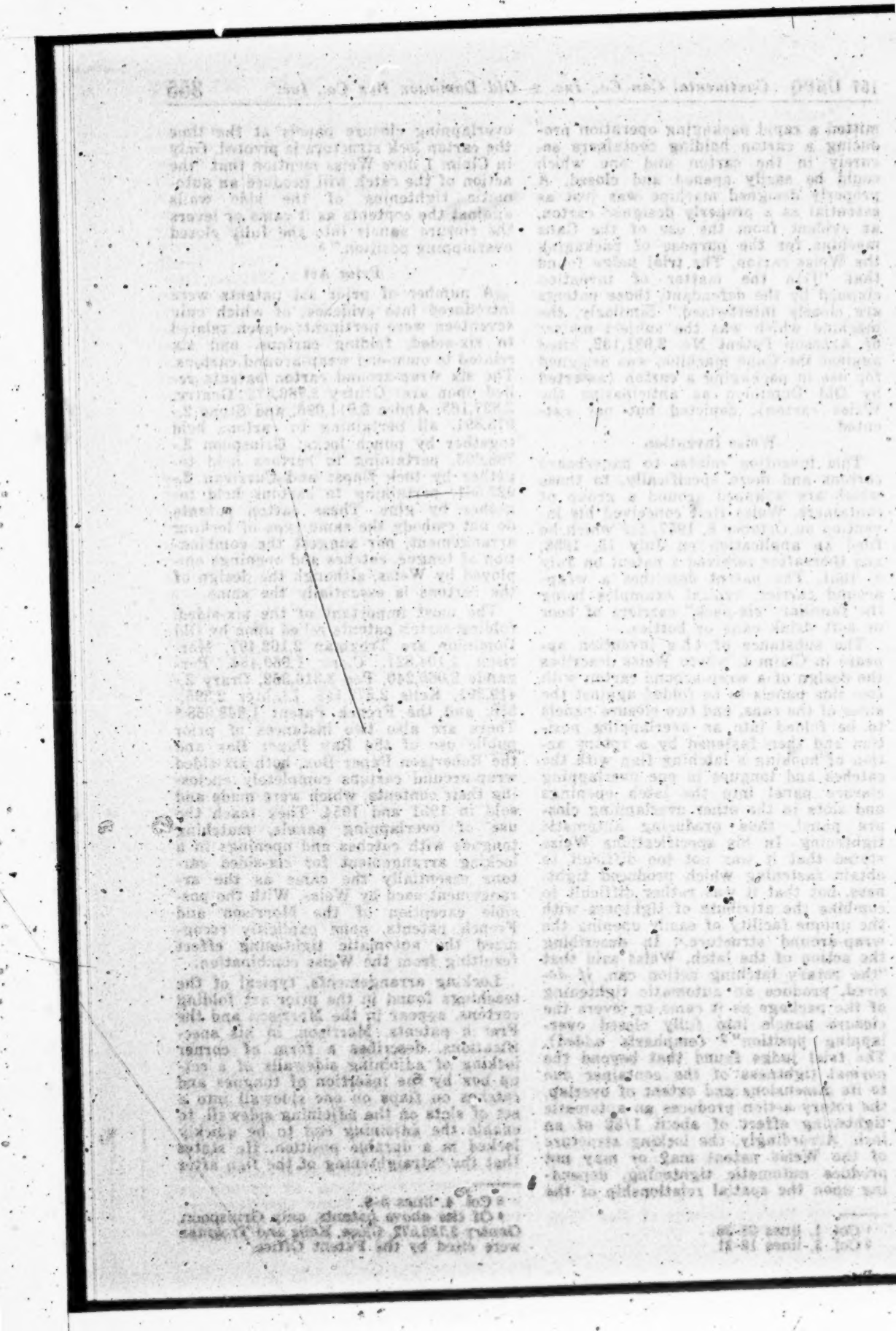
[1] Col. 1, lines 28-38.
[2] Col. 3, lines 18-21.
[3] Col. 4, lines 5-8.
[4] Of the above patents, only Grinspoon, Gentry 2,786,572, Close, Kells and Trogman were cited by the Patent Office.



insertion of the inner tongue 18 into the registering slot causes such tongue and the outer end portion of the flap to exert a leverage action between the inner end portion of the flap and the wall or side portion in which the slot is provided, whereby to draw the flap and wall closely together, and also to draw the end portion of the wall to which the flap is attached firmly against the end of the adjoining wall, as indicated at 19 in Fig. 3." [5] The French Patent also refers to the closing of a box by the use of a tongue integral with the flap to be inserted into a slot in the fixed portion of the box so that the "tongue extends, in the opposite direction from that of its free end, a miter integral with the flap by a folding line forming a hinge, marked out in advance." [6] It further provides that "in particular the closing device can be modified so as to increase the effect of the elastic force which holds the miter in its plane after closing." [7] Continental admits that the locking structure in folding cartons, other than four-sided wrap-arounds, was old in the art. In fact, Weiss testified that in a general sense, he took his lock from another type of folding carton and incorporated it into a wrap-around carton.

Invalidity

Essentially, Continental's appeal is based upon two claims: one, that the patents involving the six-sided or folding cartons and the Ray Paper Box and Robertson Paper Box cartons are not relevant prior art and two, that the function of the locking elements in the six-sided cartons is entirely different from the function provided in the combination invented by Weiss relating only to open-ended wrap-around cartons. It argues that the prior art six-sided cartons patents and the Ray and Robertson carton present no problem of losing their contents because they are closed on all sides, whereas the function of the Weiss lock in an open-ended wrap-around carton is to provide a tight package by drawing the sidewalls of the carton against the containers inside the package and then locking the closure panels by a rotary action. Continental emphasizes the fact that automatic tightening as provided by the Weiss invention, was neither intended nor accomplished by the prior art cartons.

Old Dominion contends that the Weiss locking device was amply demonstrated in the prior art patents covering six-sided cartons and also in the Ray and Robertson cartons (which were wrap-arounds), which cartons could be secured in an erected position after the overlapping closure panels had been folded over the contents and locked with tongues with catches inserted in openings, and that the locking structure could be manipulated to produce tightening.

[2] We cannot agree that the prior art patents and cartons relating to conventional six-sided, folding cartons, are not relevant art pertaining to open-ended wrap-around cartons. Nor can we agree that the fact that tightening was not the purpose or function of such locking arrangement, whether disclosed by patent or cartons in prior public use, renders such cartons irrelevant. The issue as to what prior art is relevant depends upon what a skilled person in the field would be expected to know in connection with his art (Graham v. John Deere Company of Kansas City, 383 U.S. 1, 35, 148 USPQ 459, 473-474 (1966); Mott Corporation v. Sunflower Industries, Inc., 314 F.2d 872, 878, 137 USPQ 288, 292-293 (10 Cir. 1963); Application of Shapleigh, 248 F.2d 96, 101-102, 115 USPQ 129, 132-133 (CCPA 1957)) and we believe that a person skilled in the art of designing packaging machines and wrap-around cartons would consult the disclosures in the prior art relating to conventional six-sided, folding cartons. In fact, Weiss did exactly that. While the trial judge did not make any specific finding as to what the level of skill in the pertinent art was, we believe that reference to a person who specialized in the art of designing or constructing packaging machines and folding cartons of all types was implicit in his findings.

Admittedly, the Weiss patent is a combination of old elements taken from folding cartons and applied to open-end wrap-arounds. Undoubtedly, there was a need in the industry for a new locking arrangement in wrap-arounds and, judging from its commercial success, the Weiss invention seems to have met that need. Weiss did achieve an advancement in the art of tight wrap-around packaging at high speeds by combining or arranging certain well-known carton locking structures with a rotary latching action to produce automatic tightening.

[3] Under our patent laws it is not sufficient to support patentability that a combination of elements be merely new or even represent a modest improvement in the art. Such combination must also be "nonobvious" to a person having ordinary skill in the art. 35 U.S.C.A. § 103. To uphold patentability where an invention is obvious would be "* * * to remove existent knowledge from the public domain, or to restrict free access to materials already avail-

[5] Col. 2, lines 24-35.
[6] P. 1.
[7] P. 7.

interior of the inner turning of the
the projecting slot opening
and the outer wall portion of the flap in
cave a leverage action between the
inner end portion of the flap and the
wall or side portion in which the slot is
provided, whereby to draw the flap
wall firmly together into the slot and
the end portion of the web to which the
flap is attached firmly into the slot
of the adjoining wall, as shown
in the drawing. The
relative to the closing of a box by
of a tongue into a slot on the
opposite side wall of the box so that
in the opposite direction
the one wall, a similar
flap by a folding line forming a
with the end portion of the
that in particular this closing
vide an improved
effect of the flaps
the outer
flaps and the
wherein the
wherein the
wherein

able," which violates not only Section 103 but also the Constitutional criterion. Graham v. John Deere Company of Kansas City, supra, at p. 6, 148 USPQ 462-463. The danger of removing existent knowledge from the public domain is more acute with respect to inventions involving a combination of elements or devices common in the prior art and therefore, "Courts should scrutinize combination patent claims with a care proportionate to the difficulty and improbability of finding invention in an assembly of old elements." Great Atlantic & P. Tea Co. v. Supermarket Eq. Corp., 340 U.S. 147, 152, 87 USPQ 303, 305-306 (1950). A combination invention is not patentable unless the whole is more than the sum of the parts. Ling-Temco-Vought, Inc. v. Kollsman Instrument Corp., 372 F.2d 263, 152 USPQ 446 (2 Cir. 1967).

[4] No showing has been made that any of the patents or prior use cartons cited anticipated the Weiss invention under Section 102, 35 U.S.C.A., but this failure does not eliminate such patents and cartons from the field of prior art. Depending upon how it is designed and manipulated, the locking structure of a carton, as we have seen, may or may not produce tightening. The prior art patents and cartons disclose locking structures and devices in six-sided cartons, both set-up and wrap-around, which, as demonstrated in the Morrison and French patents, can produce tightening by means of an increased overlap between the panels produced by a manipulation of the locking arrangement. The combination of the Morrison teachings with the wrap-around art makes the Weiss invention obvious. The differences between the two types of cartons were not sufficient to render nonobvious the application and adaptation of the locking arrangement disclosed in one to the purpose and function of the other.[8]

[5] Commercial success and solution of a long-standing need in the art are secondary considerations which cannot breathe life into a patent otherwise invalid because of obviousness. Calmar, Inc. v. Cook Chemical Co., sub nom. Graham v. John Deere Company of Kansas City, supra, at pp. 35-36, 148 USPQ 473-474; Preuss v. General Electric Co., Inc., 2 Cir. 157 USPQ 177. Upon this subject there is some ambiguity as to whether the difficulty in solving the packaging problem and Continental's subsequent commercial success were due to the development of the corresponding packaging machine (i.e., the Ganz machine), the patent for which was declared invalid, as well as to the development of the cartons, especially since the speed of operation was a key feature of the combined carton-machine invention. See, Welsh Manufacturing Co. v. Sunware Products Co., 236 F.2d 225, 227, 110 USPQ 161, 163 (2 Cir. 1956); Wilson Athletic G. Mfg. Co. v. Kennedy Sport. G. Mfg. Co., 233 F.2d 280, 109 USPQ 303 (2 Cir. 1956).

[7] Finally, mention should be made of the Arneson invention, which the District Court found was conceived between May 7, 1957 and June 6, 1957, earlier than the Weiss invention, but made no ruling with respect to reduction of the invention to practice. We are not here concerned with Arneson's anticipation under Section 102, an issue upon which we do not pass, but rather in the disclosures of Arneson's applications as evidence of simultaneous invention. On June 30, 1958 Arneson filed an application for a patent for a single row packaging machine, in which he included a sketch of a wrap-around carton to be used therewith, which was practically identical with the Weiss carton. It is true that in his application he did not claim the carton as part of the invention, but he did refer to folding the wrapper tightly around the cans "so that * * * the cans 10 are securely held in the wrapper."[9] On December 24, 1959, over two years after the Weiss invention (October, 1957) and a year and a half after Weiss filed his application (July, 1958), Arneson filed an application for a patent for a wrap-around carton in which the locking elements had the "inherent tendency * * * to draw the blank tight about the articles as the interlocking engagement thereof is accomplished,"[10] depicting in his sketches the Weiss locking arrangement. By an amendment dated October 23, 1961, to his 1959 application, Arneson specifically described the "automatic tightening" effect of his device. Thus the sketches of Arneson and his patent applications are evidence of a simultaneous invention and while not in the realm of anticipation or of prior art, nevertheless buttress the conclusion negating nonobviousness of the Weiss invention. Wilson Athletic G. Mfg. Co. v. Kennedy Sport G. Mfg. Co., supra; Felburn v. New

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[8] The presumption of validity attaching to issued patents is substantially weakened by the failure of the Patent Office to consider important prior art, such as the Morrison and French patents and the Ray and Robertson boxes. Formal Fashions, Inc. v. Braiman Bows, Inc., 369 F.2d 536, 152 USPQ 78 (2 Cir. 1966); Zoomar, Inc. v. Paillard Products, Inc., 258 F.2d 337, 118 USPQ 302 (2 Cir. 1958), cert. denied, 358 U.S. 908, 119 USPQ 502.

[9] Col. 2, lines 56-58.

[10] Plaintiffs' Exhibit EV-1, pp. 8-9.

able" which violates not only Section 107 but also the Constitutional provision.

Graham v. John Deere Company of Kansas City, supra, at p. 6, 148 USPQ 462. The decision of Judge Learned Hand in the patent claims in question is not entitled to any presumption of validity as to the presumption of validity as presumed by the Patent Office to consider him [illegible] at all, such as the Morrison and French patents and the Ray and Robertson, Boyer, Portnal Patents, Inc. v. Brunner News, Inc., 359 F.2d 534, 149 USPQ 19 (3 Cir. 1966); Zoomar, Inc. v. Paillard Products, Inc., 359 F.2d 321, 149 USPQ 282 (2 Cir. 1966), cert. denied, 385 U.S. 908, 150 USPQ 592.

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[1] Cont. 3, lines 64-68.

[2] Plaintiff's Exhibit EX-1, pp 8-9

line." 2 Cir. 157 USPQ 177. Upon this subject there is some ambiguity as to whether the difficulty in solving the packaging problem and Continental's subsequent commercial success were due to the development of the corresponding packaging machine (i.e., the Cans machine), the patent for which was declared invalid, as well as to the development of the cartons. Especially since the speed of operation was a key factor of the combined carton-machine invention, Doe Wrigley Manufacturing Co. v. Gardner Products Co., 258 F.2d 253, 257, 119 USPQ 151, 153 (9 Cir. 1958); Wilson Athlete G Mfg. Co. v. Kennedy Sports G. Mfg. Co., 264 F.2d 280, 199 USPQ 305 (2 Cir. 1959).

[3] Finally, motion should be made of the Arnson invention, which the District Court found was conceived between May 7, 1957 and June 6, 1957, earlier than the Weiss invention, but made no mention with respect to reduction of invention to practice. We are not here concerned with Arnson's application under Section 102, an issue upon which we do not pass, but rather in this discovery of Arnson's application as evidence of simultaneous invention. On June 30, 1958 Arnson filed an application for a patent for a single row packaging machine, in which he included a sketch of a wrap-around carton as being therewith, which was practically identical with the Weiss carton. It is the thrust of the applicant's position that Arnson refer to foil and the wrapper, thereby avoiding the case that " * * the case [0] are strongly held in the wrapper." " On December 24, 1959, over two years after the Weiss invention (earlier, 1957) and a year and a half after Weiss filed his application (July, 1958), Arnson filed an application for a wrap-around carton in which the locking elements had the "inherent tendency * * * to draw the blank tight along the articles as the interlocking engagement thereof is accomplished," in applying in his sketches the Weiss locking arrangement. By an amendment dated October 23, 1959, the application, Arnson specifically described the "automatic tightening" effect of his device. Thus the sketches of Arnson and his patent applications are evidence of a simultaneous invention and while not in the realm of anticipation or of prior art, nevertheless buttress the conclusion pertaining needlessness of the Weiss invention. Wilson Athlete G. Mfg. Co. v. Kennedy Sports G. Mfg. Co., supra; Fabius v. Saw

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" Cont. 3, lines 64-68.

[2] Plaintiff's Exhibit EX-1, pp 8-9

York Central Railroad Company, 350 F.2d 416, 146 USPQ 622 (6 Cir. 1965), cert. denied, 383 U.S. 935, 148 USPQ 771 (1966); "Subtests of 'Nonobviousness': A Nontechnical Approach to Patent Validity," 112 U. Pa.L.Rev. 1169, 1181 (1964).

Affirmed.

Court of Appeals, Fifth Circuit

BINKS MANUFACTURING COMPANY v. THE SPEE-FLO MANUFACTURING CORPORATION

No. 24851 Decided Apr. 18, 1968

PATENTS

Particular patents—Spray Gun

3,000,576, Levey and Harvey, Spray Gun, valid and infringed.—Binks Mfg. Co. v. Spee-Flo Mfg. Corp. (CA 5) 157 USPQ 358.

Appeal from District Court for Southern District of Texas, Singleton, J.; 153 USPQ 120.

Action by The Spee-Flo Manufacturing Corporation against Binks Manufacturing Company for patent infringement. From judgment for plaintiff, defendant appeals. Affirmed.

TOM ARNOLD and ARNOLD, ROYLANCE, KRUGER & DURKEE, both of Houston, Tex., for appellant.

HAROLD F. MCNENNY and MCNENNY, FARRINGTON, PEARNE & GORDON, both of Cleveland, Ohio, and EDWARD HUTCHESON and HUTCHESON, TALIAFERRO & GRUNDY, both of Houston, Tex., for appellee.

Before COLEMAN and CLAYTON, Circuit Judges, and JOHNSON, District Judge.

PER CURIAM.

The Spee-Flo Manufacturing Company, appellee, charged Binks Manufacturing Company, appellant, with infringement of Spee-Flo patent number 3,000,576. The District Court found the patent valid and infringed. The opinion of the District Court is published at 264 F.Supp. 542, 153 USPQ 120 (1967).

Although most favorably impressed by the brilliant argument of counsel for appellant, presented both orally and in briefs, we are nevertheless convinced that the District Judge was right. We see no necessity for duplication of or further comment on the opinion below.

The judgment, therefore, will be affirmed and the case remanded to the District Court for further proceedings.

Court of Appeals, District of Columbia

HOFFENBERG v. KAMINSTEIN

No. 21152 Decided Apr. 23, 1968

COPYRIGHTS

1. In general (§ 24.01)

Except when ad interim provisions of sections 22 and 23 are met, section 16 of Copyright Code allows copyright registration of English-language books by United States citizens only where first publication is printed in United States; intention of Congress is accurately reflected in 37 C.F.R. § 202.4(b) which provides that American edition of English-language book identical in substance to that first published abroad will not be registered unless ad interim registration is first made.—Hoffenberg v. Kaminstein (CA DC) 157 USPQ 358.

Appeal from District Court for District of Columbia.

Action by Mason Hoffenberg against Abraham L. Kaminstein, Register of Copyrights, to compel issuance of certificate of copyright registration. From summary judgment for defendant, plaintiff appeals. Affirmed.

CHARLES REMBAR, New York, N.Y. (MORTON E. YOHALEM, Washington, D.C., on the brief) for appellant.

MICHAEL W. WERTH and JOHN C. ELDRIDGE (EDWIN L. WEISL, JR., MORTON HOLLANDER, T. HAYWARD BROWN, BARBARA A. RINGER, and DOROTHY SCHRADER on the brief) for appellee.

STANLEY L. TEMKO, Washington, D.C., for Authors League of America, amicus curiae.

BEN COHEN, Washington, D.C., and AMSTER & ROTHSTEIN, JESSE ROTHSTEIN, and BERNARD L. GOLDSTEIN, all of New York, N.Y., for Lancer Books, Inc., amicus curiae.

Before MILLER, Senior Circuit Judge, and BURGER and WRIGHT, Circuit Judges.

PER CURIAM.

Appellant and Terry Southern, both American citizens, are co-authors of the novel "Candy" which was first printed and published in the English language in France in 1958 with the appropriate